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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/220,986	12/23/1998	SAM SCHWARTZ	17649-20	5361

7590

12/20/2001

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EXAMINER

KISHORE, GOLLAMUDI S

ART UNIT	PAPER NUMBER
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1615

19

DATE MAILED: 12/20/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/220,986

Applicant(s)

Schwartz

Examiner
Gollamudi S. Kishore, Ph.D

Art Unit
1615



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 9, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

The request for the extension of time and amendment filed on 10-9-01 are acknowledged.

Claims pending in this application are 14-18.

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what this term, non-oily' represents in terms of specific compounds. Are they hydrophilic? This rejection is maintained since this issue was not adequately addressed by applicant.

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 14-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Stavroff (US 5,866,145).

Stavroff discloses compositions containing dead sea salts, an emollient, a skin conditioner and fragrance (note the abstract, and columns 1-2).

Applicant's arguments have been fully considered, but still are not found to be persuasive. Applicant once again argues that Stavroff is not prior art based on the declaration provided. In support, applicant cites In re Stempel. The rationale according to applicant, based on In re Stempel, is as follows: "Stavriff et al. 145 teches a genus that includes a Dead Sea salt and an emollient. Applicant, by way of the Lewis declaration, has shown that it had prepared a composition containing Dead Sea salt and an emollient before the filing date of Stavroff et al. 145, January 28, 1997. The lipid soluble ingredients shown in the exhibit of photocopied page 108 to the Lewis declaration includes a number of ingredients that one ordinary skill in the art would recognize as emollients". This argument is not found to be persuasive since the cited case law is not applicable in instant

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case. A careful examination of the declaration indicates that what applicant reduced to practice is a cream containing large amounts of water and lesser amounts of Masada salt. This means that what applicant had was a solubilized preparation of the salt in water (salt is soluble in water; 53 to 64% of water is used while the salt used is only 5 % in the declaration) where as the claims are drawn to a composition in which the salt is in a suspended state. Stavroff on the other hand is a different composition from the composition which applicant has shown as one reduced for practice in that the salt amounts are 50-80 % and is a polisher in which this salt is in a suspended state. Since they are altogether different compositions, the cited case law based on 'genus-species relationship between an invention and the reference is not applicable in instant case. Furthermore, as previously pointed out, the declaration shows the use of Masada salt. The reference teaches Dead sea salt. The differences are unclear. Therefore, the reference is deemed to be applicable.

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 14-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1479 199 in view of JP 08113530, Biener (4943432) by themselves or in combination.

GB discloses compositions containing salt crystals, propylene glycol and emollient for the skin treatment (note the entire patent, Example 3 and claims in particular). GB however, does not teach that the salt crystals are those obtained from Dead Sea.

JP teaches that the salt obtained from Dead Sea salt has excellent skin beautifying actions (note the abstract).

Biener similarly teaches that Dead Sea salt and a salt mixtures which is an excellent therapeutic agent for skin diseases (note col. 1, line 27 et seq.).

The use of the salt obtained from Dead Sea in the salt compositions taught by GB would have been obvious to one of ordinary skill in the art because of the excellent skin beautifying effects and the therapeutic effect taught by JP and Biener.

Applicant's arguments have been fully considered, but are not found to be persuasive. Applicant argues that in JP and in Biener, the salt is in solution form. This argument is not found to be persuasive because these references teach the the added benefits of the salt from Dead sea and these properties would remain the same irrespective of whether the salt is in the solubilized state or in suspended state and applicant has not shown that to be otherwise. Furthermore, within the skill of the art to recognize that salt will solubilize once it comes into contact with water and as noted from instant specification.

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In addition, the examiner points out that the primary reference of GB clearly teaches the salt composition for abrasion purposes, just as in instant invention except that the salt is not from Dead Sea. The rejection is maintained.

7. Claims 14-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stavroff cited above, further in view of Steward (5,922,313).

Stavroff does not teach instant additives in the skin treatment compositions.

Steward teaches that the addition of additives such as propylene glycol, aloe and lipomulse are common practice in the art (note the abstract, column 4 and examples).

The inclusion of components such as emollients and others not taught by Stavroff would have been obvious to one of ordinary skill in the art since these are commonly used components in skin care preparations as taught by Steward and one would expect the best possible results by adding these components.

Applicant's arguments with regard to Stavroff have been addressed above.

Applicant argues that Steward fails to teach Dead Sea salts. The examiner agrees, but points out that the reference is combined for the teachings of the additives and not for the teachings of Dead Sea salt. The rejection is maintained.

8. Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stavroff in view of Steward (5,922,313) as set forth above, in further combination with Chodosh (5,827,870).

Stavroff and Steward do not teach the addition of pumice in the compositions.

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The reference of Chodosh which discloses an antimicrobial composition teaches that the addition of pumice in body scrubs is a routine practice in the art (note col. 5, lines 62-65). The addition of other scrubbing agents expecting the additional exfoliating effect would have been therefore, obvious to one of ordinary skill in the art.

Applicant's arguments with regard to Stavroff and Steward have been addressed above. Applicant argues that Chodosh fails to teach Dead Sea salts. The examiner agrees, but points out that the reference is combined for the teachings of pumice in the body scrubs and not for the teachings of Dead Sea salt. The rejection is maintained.

Applicant's arguments have been fully considered, but are not found to be persuasive. Applicant's arguments again pertain to Stavroff as the prior art. These have been addressed above.

9. Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1479 199 in view of JP 08113530, Biener (4943432) by themselves or in combination, further in combination with Chodosh (5,827,870).

GB, JP and Biener do not teach the use of pumice or silica.

The reference of Chodosh which discloses an antimicrobial composition teaches that the addition of pumice in body scrubs is a routine practice in the art (note col. 5, lines 62-65). The addition of other scrubbing agents expecting the additional exfoliating effect would have been therefore, obvious to one of ordinary skill in the art, with the expectation of obtaining the best possible results.

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Applicant's arguments with regard to GB, JP and Biener have been addressed above. Applicant argues that Chodash fails to teach Dead Sea salts. Applicant further argues that Chodash is too general to provide guidance to one of ordinary skill in the art for the use of Dead Sea salts. The examiner points out that the reference is combined for the teachings of pumice in the body scrubs and not the teachings of Dead Sea salt. The rejection is maintained.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *G.S. Kishore* whose telephone number is (703) 308-2440.

The examiner can normally be reached on Monday-Thursday from 6:30 A.M. to 4:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, T.K. Page, can be reached on (703)308-2927. The fax phone number for this Group is (703)305-3592.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [thurman.page@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1235.



Gollamudi S. Kishore, Ph. D

Primary Examiner

Group 1600

gsk

December 19, 2001